

Patent Right	Date	September 26, 2024	Court	Tokyo District Court, 40th Civil Division
	Case number	2023 (Wa) 70619, 2024 (Wa) 70047		
- A case in which the court determined that an appeal seeking a declaratory judgment on the Plaintiff's ownership of the patent lacks the benefit of legal action or is unlawful in light of the purport of the Patent Act, and dismissed the appeal.				

Case type: Compensation

Result: Dismissed

2023 (Wa) 70619: principal action to seek compensation for damages (hereinafter referred to as the "Principal Case"), and 2024 (Wa) 70047: counterclaim action against a case of seeking compensation for damages (hereinafter referred to as the "Counterclaim Case")

Summary of the Judgment

In the Principal Case, the Plaintiff, who is a former employee of the Defendant, argued that it was determined in the prior instance that the Invention is the Defendant's employee invention and the Patent Right belonged to the Defendant, and therefore, the Plaintiff had to pay the costs that the Plaintiff did not have to pay in relation to the Patent. The Plaintiff demanded that the Defendant pay compensation for damages of 7,810,000 yen based on tort and delay damages and sought a declaratory judgment on the Plaintiff's ownership of the Patent Right.

In the Counterclaim Case, the Defendant argued against the Plaintiff that this lawsuit on the Principal Case unreasonably resurrected the determinations made so far and filing of this lawsuit constitutes a tort. The Defendant demanded that the Plaintiff pay part of the compensation for damages of 5,000,000 yen and delay damages based on tort.

In the Judgment, the court determined as summarized below and concluded that the appeal seeking a declaratory judgment on the Plaintiff's ownership of the Patent Right lacks the benefit of legal action or is unlawful in light of the purport of the Patent Act.

The second instance of the third lawsuit determined in its grounds for determination that the Patent is a misappropriated application and is invalid. In response to this, the Plaintiff argued in this case that the Patent is not a misappropriated application and is valid and sought a declaratory judgment on the Plaintiff's ownership of the Patent Right.

However, the establishment of the Patent was effectively registered with the Plaintiff as a patentee. Even if the judgment of the second instance in the third lawsuit

determined in its ground for determination that the Patent is a misappropriated application and is invalid, the Patent will not become invalid to a third party based on the relevant determination. Then, the appeal of seeking the declaratory judgment is not necessary and lacks the benefit of legal action. Originally, the Plaintiff's claim for a declaratory judgment was to seek confirmation of the Plaintiff's ownership of the Patent Right on the assumption of the effect on a third party as to whether the Patent is invalid or not. Article 123 of the Patent Act stipulates that whether the patent is invalid shall be determined primarily by the Japan Patent Office, which has advanced technical expertise on patents in a trial for patent invalidation. Article 178, paragraph (6) of the Patent Act stipulates that it is not allowed to file an appeal of seeking the aforementioned determination directly before the court without undergoing a trial for patent invalidation. Then, a claim for a declaratory judgment on the assumption of the effect on a third party as to whether the Patent is invalid or not is against the purport of the aforementioned provisions and is unlawful.

Therefore, the Plaintiff's appeal to seek a declaratory judgment is determined to lack the benefit of legal action or to be unlawful in light of the purport of the Patent Act and should be dismissed.

Based on the above, this judgment dismissed the Plaintiff's appeal seeking a declaratory judgment on the Plaintiff's ownership of the Patent Right and rejected all the remaining principal claims and counterclaims.